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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/623,443	Applicant(s) LUKE ET AL.	
	Examiner C. R. Richard	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-36, 40-47, 49, 53-55, 58, 61, 62, 65, 106-132 and 134 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-36, 40-47, 49, 53-55, 58, 61, 62, 65, 106-132 and 134 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/2/05 to 1/17/06</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 33-36,40-47,49,53-55,58,61,62,65,106-132 and 134.

DETAILED ACTION

Election/Restrictions

1. In a response filed 7 December 2005, Applicant has confirmed the provisional election without traverse to prosecute the invention of group II (claims 33-105).

2. In a response filed 7 December 2005, Applicant has confirmed the provisional species election without traverse to prosecute (I) the zeolite clinoptilolite; (II) the polymer hydroxyethyl cellulose; (III) the dispersant sodium naphthalene sulfonate condensed with formaldehyde; and (IV) the surfactant species (f) of claims 62 and 100 (a specified ethoxylated alcohol ether sulfate).

These species were examined in the previous Office Action and were found unpatentable over the prior art when considered individually. The subject matter indicated as allowable depended on combinations of these elected species. Per MPEP 803.02, in order to continue prosecution in this second action, the Examiner now selects the species to be examined in the pending claims as amended, claims 33-36, 40-47, 49, 53-55, 58, 61-62, 65, 106-132 and 134. The species selected are (I) the zeolite faujasite, (II) the polymer ethyl cellulose, (III) the dispersant sodium naphthalene sulfonate condensed with formaldehyde and (IV) the surfactant species (f) of claim 62 as now amended.

Note that the rejections made below are based on the claims as they read and not only to the elected species. This will allow for more speedy overall prosecution and

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make it easier for Applicant to make appropriate amendments. Other, as yet non-elected, species are sometimes pointed out below.

Information Disclosure Statement

3. Some of the information disclosure statements acknowledged along with this Office Action fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The entries corresponding to the missing copies are marked through as not considered.

Note that copies of some Office Actions in related cases were included the IDS's acknowledged with this Office Action; these copies sometimes contained complete form 1449's from these other cases. These 1449's were ignored by the Examiner as not properly presented for consideration in the present case.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 47, 115 and 130 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, there is overlap between components in these claims. A zeolite may be considered a clay.

6. Claims 62, 119 and 121 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, a sulfonate in (d), (d) and (e), respectively is shown, not a sulfate as stated.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 33-36, 43-44, 47 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Kulprathipanja et al. in US Patent 4,372,876.

This reference teaches an absorbent made in part by combining an uncoated precursor with a polymer in a liquid organic solvent [carrier], then removing the solvent; the product absorbent may then be contacted with an aqueous solution or water [carrier] (see Abstract). The uncoated precursor may be a faujasite bound to a clay and the polymer may be ethylcellulose (see Example 1). The solvent may be toluene (see column 9, line 61).

The uncoated precursor may be a crystalline aluminosilicate dispersed in an inorganic matrix that is coated with a cellulose ether (see claim 1). The aluminosilicate may be an X or Y zeolite [both are faujasites] (see claim 3). The organic matrix may be a natural clay (see claim 6). The cellulose ether may be ethyl cellulose (see claim 2).

The fluid compositions disclosed here could be used as treating fluids such as drilling or spacer fluids. Note that a new intended use does not impart patentability on an otherwise old or obvious invention. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

9. Claims 33-36, 40, 43-44, 47, 49, 55, 58, 61, 65, 106-110, 113-116 and 120 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sirosita et al. in US Patent 4,986,989. The law of 35 USC 103(a) is summarized below.

This reference discloses a composition with a faujasite, chabazite or phillipsite as an active ingredient (see Abstract). The zeolite may be mixed with solid carriers, liquid carriers, surface active agents and auxiliaries (see column 3, lines 40-45). Possible solid carriers include calcite [calcium carbonate] and clays like bentonite (see column 3, lines 47-51), and the liquid carrier may be water (see column 3, lines 51-52). Possible surfactants are an alkyl sulfate salt or naphthalenesulfonic acid/formalin condensate (see column 3, lines 53-62), and possible auxiliaries include polyvinyl alcohol, gum arabic, and carboxymethyl cellulose (see column 3, lines 62-65).

The fluid compositions disclosed here could be used as treating fluids such as drilling or spacer fluids. Note that a new intended use does not impart patentability on an otherwise old or obvious invention. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

The dispersant species elected is actually called out as “sodium naphthalene sulfonate condensed with formaldehyde”. The reference teaches a naphthalenesulfonic acid/formalin condensate, but does not mention sodium specifically. Of course, taking sodium as necessarily relevant when talking about the product itself (which is the species of interest) in water is debatable. Even if the reference does not anticipate the rejected claims that recite this dispersant because of this issue concerning sodium, it renders it obvious. A sodium salt would at least be obvious to one of ordinary skill in the art for this sulfonate.

10. Claims 106-109 and 113-114 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over disclosures

by Ku in US Patent Application Publication 2002/0117090. Ku teaches various concretes. The law of 35 USC 103(a) is summarized below.

Ku teaches concretes containing cement (a viscosifier of sorts), water (a carrier), Y-Zeolite (a faujasite), SNF (sulphonated naphthalene formaldehyde) and sand (a type of weighting agent) (see paragraphs 25 and 37-39). The compositions of Ku could be used in well treatment, especially in completion and even as a spacer, at least until they fully set. Note that a new intended use does not impart patentability on an otherwise old or obvious invention. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

The dispersant species elected is actually called out as "sodium naphthalene sulfonate condensed with formaldehyde". Ku teaches a sulphonated naphthalene formaldehyde, but does not mention sodium specifically. Of course, the condensate as called out is a type of SNF, and taking sodium as necessarily relevant when talking about the product itself (which is the species of interest) in water is debatable. Even if Ku does not anticipate the rejected claims that recite this dispersant because of this issue concerning sodium, it renders them obvious. A sodium salt would at least be obvious to one of ordinary skill in the art for this sulfonate.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 33-36, 41-47, 53-55, 58, 106-109, 113-115 and 117 are rejected under 35 U.S.C. 103(a) as obvious over disclosures in WO 98/54108 in view of Ku et al. in US Patent Application Publication 2002/0117090. The WO reference corresponds to US Patent 6,645,289 to Sobolev et al. The WO references teaches cement based materials. Ku has been discussed in detail above.

The WO reference discloses an admixture that may include zeolite, SNF (sulphonated naphthalene formaldehyde) which has water content associated with it, clay and hydroxyethyl cellulose, among other components (see pages 3-5). The admixture may be added to oil-well cement (a viscosifier of sorts) (see page 7, line 30); use in well completion is thus implied (or at the very least obvious to one of ordinary skill in the art from this teaching). The cement would of course be useful in well treatments of various other types, even as a spacer, before it sets. Note that a new intended use does not impart patentability on an otherwise old or obvious invention. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

The dispersant species elected is actually called out as “sodium naphthalene sulfonate condensed with formaldehyde”. The WO reference teaches a sulphonated naphthalene formaldehyde, but does not mention sodium specifically. Of course, the condensate as called out is a type of SNF, and taking sodium as necessarily relevant when talking about the product itself (which is the species of interest) in water is debatable. Even if the WO reference does not anticipate the rejected claims that recite this dispersant because of this issue concerning sodium, it renders them obvious. A sodium salt would at least be obvious to one of ordinary skill in the art for this sulfonate.

The WO reference does not teach a specific zeolite.

As discussed above Ku teaches a concrete made up of cement, water, a zeolite like faujasite, SNF and sand. The use of the zeolite is noted to enhance compressive strength of the concrete (see Ku Abstract). Ku gives emphasis to using faujasite (see Ku paragraphs 24-26 and Table 1 for example).

Given the similarity of the compositions of the WO reference and Ku, and the teachings of Ku as to strength enhancement and the emphasis of faujasite as the zeolite in Ku, one of ordinary skill in the art would have been motivated to select faujasite as the zeolite in the composition of the WO reference. The rejected claims are thus rendered obvious.

As to claims 41-42 and 45-46, the amounts recited would be produced in the routine optimization of the components and hence are obvious.

13. Claims 33, 61-62, 106-109, 111-114, 118-119, 121-132 and 134 are rejected under 35 U.S.C. 103(a) as being obvious over Ku et al. in US Patent Application Publication 2002/0117090 in view of Roddy in US Patent 6,457,524 and Chatterji et al. in US Patent 5,588,489.

Ku teaches concretes containing cement (a viscosifier of sorts), water (a carrier), Y-Zeolite (a faujasite), SNF (sulphonated naphthalene formaldehyde) and sand (a type of weighting agent) (see paragraphs 25 and 37-39). The compositions of Ku could be used in well treatment, especially in completion and even as a spacer, at least until they fully set. Note that a new intended use does not impart patentability on an otherwise old or obvious invention. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

The dispersant species elected is actually called out as "sodium naphthalene sulfonate condensed with formaldehyde". Ku teaches a sulphonated naphthalene formaldehyde, but does not mention sodium specifically. Of course, the condensate as called out is a type of SNF, and taking sodium as necessarily relevant when talking about the product itself (which is the species of interest) in water is debatable. Even if Ku does not anticipate the rejected claims that recite this dispersant because of this issue concerning sodium, it renders them obvious. A sodium salt would at least be obvious to one of ordinary skill in the art for this sulfonate.

Ku does not teach the elected surfactant.

Roddy teaches well cementing (completion) compositions and methods. The compositions of Roddy may contain (among other components) a cement material (a viscosifier), a flow enhancing zeolite, water and the ethoxylated alcohol ether sulfate

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surfactant shown on line 35 of column 5 of the reference (corresponding exactly to surfactant (f) of present claim 62 at least, the elected surfactant) (see columns 4 and 5 of Roddy); this is a salt of an ethoxylated alcohol sulfate. The surfactant acts to foam the cement (see column 5, lines 25-40). Use in well cementing (completion) is given in column 8. The fluid could be used in fracturing or as a spacer, before it sets up at least. Note that a new intended use does not impart patentability on an otherwise old or obvious invention. *In re Pearson*, 181 USPQ 641 (CCPA 1974). **Note however this reference is a 102(a) type in addition to others.**

Chatterji teaches various advantages of foaming a cement used in wells, such as compressibility (see column 3) and gives many examples of foaming agents (see columns 5-7). Note that the formula given at lines 20-30 includes that of the surfactant of Roddy.

From the teachings of Roddy and Chatterji, one of ordinary skill in the art would have been motivated to use the surfactant of Roddy to foam the composition of Ku to enhance its utility in wells, thus rendering the rejected claims obvious. This is especially true given the similarity in the Ku and Roddy compositions and the surfactants of Roddy and Chatterji.

Roddy also teaches the advantages of many common additives which would then also have been obvious to include in the compositions of Ku (see Roddy column 6, lines 27-35). This teaching is applied as follows. As to claim 62, Ku does not teach any of the polymers recited, but at least most of these are well known fluid loss control compounds suggested by Roddy. Similarly, the clays and polymers of claims 130-132

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missing from Ku are suggested by Roddy. As to claim 134, Ku does not teach weighing agents, but the common ones of claim 134 are suggested by Roddy.

As to claims 111-112 and 126-127, the amounts recited would be produced in the routine optimization of the components and hence are obvious.

As to claim 125, none of the zeolites are the elected species, but Ku suggests that other zeolites could be used as well (see Ku Abstract).

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claim 106 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16, 54 and 66 of copending Application No. 10/315,415. Although the conflicting claims are not identical,

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they are not patentably distinct from each other. The cited claims of 10/315,415 disclose a composition having a zeolite such as chabazite and a sulfonated acetone formaldehyde condensate, used in cementing a well (completion) which meets the limitations of the rejected claim.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 33 and 106 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 12, 18-21, 23, 35, 44, 50-53 and 55 of copending Application No. 10/795,158. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 3 and 35 of 10/795,158 disclose a drilling composition having a zeolite such as chabazite in a carrier fluid, while claims 12, 18-21, 44 and 50-53 disclose the use of a cellulose based and other polymers combined with zeolites in a carrier; it would have been obvious to combine the compositions of 10/795,1548 claim 3 with claim 12, 18, 19, 20 or 21 and claim 35 with claim 44, 50, 51, 52 or 53 to obtain the compositions of rejected claim 33. Similarly, the obvious combination of the compositions disclosed in claim 3 and 23, as well as claim 35 and 55 (of 10/795,158) results in a composition within the scope of claim rejected 106.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claim 33 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 9, 54 and 60 of copending Application No.10/816,034. Although the conflicting claims are not identical, they are not patentably distinct from each other. The obvious combination of the compositions disclosed in claims 3 and 9, as well as claims 54 and 60 of 10/816,034 meet the limitations of rejected claim 33.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. Claim 33 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 10 and 15 of copending Application No.11/126,626. Although the conflicting claims are not identical, they are not patentably distinct from each other. The obvious combination of claims 3, 10 and 15 of 11/126,626 discloses a composition which meets the limitations of the rejected claim.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19. Claims 33 and 106 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 11-12, 22 and 30 of copending Application No.11/270,307. Although the conflicting claims are not identical, they are not patentably distinct from each other. The obvious

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combination of claims 5 and 11 of 11/270,307 discloses a composition which meets the limitations of rejected claim 33. The obvious combination of claims 5 and 12, as well as claims 22 and 30 of 11/270,307 discloses a composition which meets the limitations of rejected claim 106.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. This is a NEW rejection as this reference application has only recently been filed.

Response to Arguments

20. Applicant's arguments filed 7 December 2005 have been fully considered but they are not persuasive.

Applicant has made many claim amendments, cancelled some claims and added new claims. Claims 33-36, 40-47, 49, 53-55, 58, 61-62, 65, 106-132 and 134 are pending. Note, there has never been a claim 133 presented in this case for some reason.

The Examiner notes that Applicant has not explained where support can be found for any of the claim amendments or new claims. It is at least customary to do, and leads to smoother prosecution when done.

The Examiner comments here on the statements made by Applicant regarding cancellation of claims. All of the claims cancelled in the elected group were shown to be anticipated or obvious over the prior art in the previous action. They would have had to

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be cancelled as a result regardless of other reasons Applicant alleges to have had for doing so. The Examiner wants to make it clear on the record that he does **not** acquiesce on the merits of any rejections/objections made over cancelled claims – they are merely rendered moot by the cancellations.

As to the restriction and election of species, Applicant has confirmed the earlier election by telephone. The Examiner notes that Applicant has chosen to cancel the claim not elected instead of merely withdrawing them.

The Examiner has considered the translated French document 763,998 supplied and initialed the form 1449 corresponding accordingly.

As to the rejections under 35 USC 112, second paragraph from the last Office Action, the Examiner notes Applicant's statements concerning cancellation of some of the claims involved here; the comments made above concerning cancelled claims rejected previously applies here also.

As to a zeolite not being a clay, the art is replete with references that zeolites may be regarded as clays. Take for example US Patent 2,094,316 cited in the last Office Action at column 3, line 1, "[t]his particular zeolitic clay...". Another example can be found in US Patent 3,293,040 at column 3, where under the heading "Natural clays" are listed "Zeolites" such as "natrolite".

As to exhibit A, zeolites are not mentioned as clays, but they are not excluded explicitly, nor has Applicant explained how this definition would exclude zeolites implicitly. The Examiner contends that given the patents just cited, the term "clay" may encompass zeolites. Note that exhibit A has not been included on a form 1449 and will

not be considered part of the record in this case beyond the limited purpose described here. This 112 rejection is maintained as to the remaining claim 47 and expanded to new claims.

As to the 112 rejection involving the "x" parameter, the Examiner notes that this rejection is rendered moot by the cancellation of claims 39 and 77. There is no reason for the Examiner to consider the actual argument offered by Applicant on this point.

As to the 112 rejection of claims 62 and 100, Applicant's amendments take care of it, and this rejection is withdrawn. Note that in claim 62(d), 119(d) and 121 (e), a sulfonate, not a sulfate is shown and a rejection above is made accordingly.

As to the rejection under 35 USC 102(b) over Kiss, it is withdrawn as it is moot over Applicant's claim amendments. The Examiner rejects Applicant's assertion that the remaining members of the species groups must now all be examined as a result of Applicant amending around this rejection; instead, the Examiner has made a new selection of species in the groups as indicated above to continue examination upon per the MPEP.

As to sludge being a carrier fluid, Applicant is reminded that the issue is not whether an optimal fluid would result, but one that would perform as required. Almost any fluid could be used in some type of well treating and that of Kiss certainly could.

As to the contention that a sewage sludge wouldn't contain at least one of an organic polymer, a viscosifier or a colloid, the Examiner invites Applicant to look up the word sludge as he did - the word viscous is prominently featured in at least one

definition. Additionally, it would be hard to imagine (municipal) sewage sludge not containing some organic polymer (perhaps even cellulose) or colloid.

As to the rejection under 35 USC 102(b) over Cross, the Examiner withdraws it as moot because Applicant has amended around it. The Examiner rejects Applicant's assertion that the remaining members of the species groups must now all be examined as a result of Applicant amending around this rejection; instead, the Examiner has made a new selection of species in the groups as indicated above to continue examination upon per the MPEP.

The Examiner wishes to point out that Applicant's argument concerning Cross and zeolites is flawed. First, Cross goes beyond a generic teaching of zeolites by specifically teaching the use of natrolite in column 3, lines 30-35. As to the distinction/selection of zeolites, Applicant has admitted that this makes no real difference to a working well treatment fluid. Original claim 33 recited "[a] treating fluid composition comprising: zeolite and a carrier fluid", and the specification at page 3 paragraph 13 states "[it] is to be understood that as used in this application, the term "zeolite" means and encompasses all natural and manmade forms of zeolites". The specification at page 3, paragraph 14 states "[p]referred zeolites for use in the well treating fluid ... **include** [followed by 17 named classes of zeolites]" (emphasis added). Referring to exhibit B, these 17 classes appear to be a good cross section of zeolites; note that exhibit B has not been included on a form 1449 and will not be considered part of the record in this case beyond the limited purpose described here. Applicant does not appear to provide "guidance" beyond what is stated here in "selection".

As to the rejection under 35 USC 102(b) over Mueller, the Examiner withdraws it as moot because Applicant has amended around it. The Examiner rejects Applicant's assertion that the remaining members of the species groups must now all be examined as a result of Applicant amending around this rejection; instead, the Examiner has made a new selection of species in the groups as indicated above to continue examination upon per the MPEP.

As to the rejection under 35 USC 102(b) over Terry, the Examiner withdraws it as moot because Applicant has amended around it. The Examiner rejects Applicant's assertion that the remaining members of the species groups must now all be examined as a result of Applicant amending around this rejection; instead, the Examiner has made a new selection of species in the groups as indicated above to continue examination upon per the MPEP.

As to the rejection under 35 USC 102(a) and (e) over Roddy, the Examiner withdraws it as moot because Applicant has amended around it. The Examiner rejects Applicant's assertion that the remaining members of the species groups must now all be examined as a result of Applicant amending around this rejection; instead, the Examiner has made a new selection of species in the groups as indicated above to continue examination upon per the MPEP.

As to the rejection under 35 USC 102(b)/103(a) over WO 98/54108, the Examiner withdraws it as moot because Applicant has amended around it. The Examiner rejects Applicant's assertion that the remaining members of the species groups must now all be examined as a result of Applicant amending around this

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rejection; instead, the Examiner has made a new selection of species in the groups as indicated above to continue examination upon per the MPEP. Note that the reference teaches use in an oil well cement which is a treating fluid (at least before it totally sets) – Applicant has admitted this in original claim 68 for example where a completion fluid is a type of well treating fluid. In any case, a (fluid) cement can function in other types of well treatment as can most fluids.

As to the rejection under 35 USC 102(b)/103(a) over Reddy, the Examiner withdraws it as moot because Applicant has amended around it. The Examiner rejects Applicant's assertion that the remaining members of the species groups must now all be examined as a result of Applicant amending around this rejection; instead, the Examiner has made a new selection of species in the groups as indicated above to continue examination upon per the MPEP. Note that the reference teaches well treating fluids.

As to the rejection under 35 USC 102(e)/103(a) over Ku, the Examiner withdraws it as moot because Applicant has amended around it. The Examiner rejects Applicant's assertion that the remaining members of the species groups must now all be examined as a result of Applicant amending around this rejection; instead, the Examiner has made a new selection of species in the groups as indicated above to continue examination upon per the MPEP. New rejections using Ku are presented above. Note that the reference teaches compositions that could be used as treating fluids (like for completion); suitable for use is the issue, not optimal functionality.

As to the rejections under 35 USC 103(a) over Mueller, Reddy, Terry and Roddy, the Examiner withdraws it as moot because Applicant has amended around it. The

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Examiner rejects Applicant's assertion that the remaining members of the species groups must now all be examined as a result of Applicant amending around this rejection; instead, the Examiner has made a new selection of species in the groups as indicated above to continue examination upon per the MPEP.

As to the rejections under 35 USC 103(a) over Cross, the Examiner withdraws it as moot because Applicant has amended around it. The Examiner rejects Applicant's assertion that the remaining members of the species groups must now all be examined as a result of Applicant amending around this rejection; instead, the Examiner has made a new selection of species in the groups as indicated above to continue examination upon per the MPEP.

The Examiner notes that Applicant has not provided a persuasive argument against the Examiner's contention that clinoptilolite is an obvious substitute for natrolite.

As to the double patenting rejections over US Patent 6,889,767, the Examiner withdraws this rejection as moot due to Applicant's claim amendments.

As to the double patenting rejections over US Patent Application 10/315,415, this rejection is maintained in a revised form as explained above. The Examiner observes that Applicant is under some misconceptions as to application of a rejection for double patenting. First, what another Examiner does or does not do in another case is not controlling. Second, double patenting does not necessarily work in both directions anyway. Third, there is no hindsight issue here; the claims in the application on which the rejection is based act as "the reference" for the rejection.

As to the double patenting rejections over US Patent Application 10/727,370 the Examiner withdraws this rejection as moot due to Applicant's claim amendments.

As to the double patenting rejections over US Patent Application 10/738,199 the Examiner withdraws this rejection as moot due to Applicant's claim amendments. The Examiner reaches this conclusion by interpreting "lignosulfonates and interpolymers of acrylic acid" in claim 106 to mean that both are required to satisfy the limitation and lignosulfonate alone will not suffice.

As to the double patenting rejection over US Patent Application 10/795,158, this rejection is maintained in a revised form as explained above. The Examiner takes exception to Applicant's characterization of his rejection as devoid of a "clear" showing. It should be crystal clear to Applicant from what the Examiner has said that the rejection was proper – some of the claims of the "reference" are probably even anticipatory which is more than required for obviousness. The Examiner believes that it would simply be a waste of resources to respond further to what appears to be mere posturing by Applicant.

As to the double patenting rejection over US Patent Application 10/816,034, this rejection is maintained in a revised form as explained above. Applicant should refrain from making statements like "improper hindsight analysis" was used without explanation. There is no hindsight here.

As to the double patenting rejections over US Patent Application 10/822,459 the Examiner withdraws this rejection as moot due to Applicant's claim amendments. The

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Examiner does not understand the relevance of Applicant's arguments (some are even incomplete) in any case. Similar arguments have been refuted above in any case.

As to the double patenting rejections over US Patent Applications 10/901,507; 10/939,902; 10/954,116 and 11/001,442, the Examiner withdraws the rejections as moot due to Applicant's claim amendments.

As to the double patenting rejection over US Patent Application 11/126,626, this rejection is maintained in a revised form as explained above. The Examiner disagrees that this rejection is premature – it is a provisional rejection after all.

A new provisional double patenting rejection is made above over newly filed US Patent Application 11/270,307.

The Examiner rejects Applicant's assertion in "AD." of the response of 7 December 2005 that the remaining members of the species groups must now all be examined as a result of Applicant writing claims containing, but not limited to, subject matter that has been indicated as allowable; instead, the Examiner has made a new selection of species in the groups as indicated above to continue examination upon per the MPEP. Applicant should note that the allowable subject matter depends on a combination of elected species, not on individual species; the combination of species required in the amended claims was not required in the original claim set – at least not in many of the claims.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure: US Patents 3,293,040; 3,781,225; and 3,888,998.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

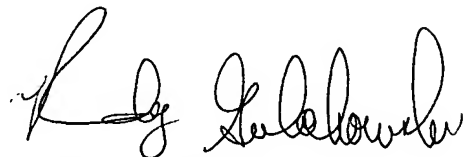
Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. R. Richard whose telephone number is 571-272-8502. The examiner can normally be reached on M-Th, 8am-6pm and alternate Fridays, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Randy Gulakowski", is positioned above the printed name and title.

RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700